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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,562	09/08/2003	**Michael Gauselmann**	ATR-A-121-1P	3426

32566 7590 07/11/2008
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EXAMINER	
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ART UNIT	**PAPER NUMBER**
3714	

MAIL DATE	DELIVERY MODE
07/11/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/658,562	GAUSELMANN, MICHAEL	
	Examiner	Art Unit	
	Corbett B. Coburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 April 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-5,7-10,13-15,18-20,22-26,39,40 and 59* is/are pending in the application.

4a) Of the above claim(s) *2-5,7-10,13-15,20,23,25-36,39 and 40* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18, 19, 22, 24 & 59* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 18, 19, 22, 24 & 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (US Patent Number 6,224,482) in view of Bueschel (*Lemons, Cherries & Bell Fruit Gum*, Royal Bell Books, 1995 page 85) & Acres et al. (US Patent Number 5,655,961).

Claims 18, 19, 24: As noted in the previous office action, Bennett teaches the invention substantially as claimed, but fails to teach dynamically adjusting the percentage of wagers from the paid games to the free game pot depending on a level of the free game pot. Jackpots were adopted early in the history of the slot machine. In the 1920's, jackpots became popular. On page 85 of Bueschel's book, there is a copy of an advertisement from that period. It explains how jackpots were funded. A player put a coin in the slot & if the jackpot was not full, the coin went into the jackpot. If the jackpot was full, the coin either went into another jackpot (even in the 1920's, slot machine designers knew the importance of making sure there was a full jackpot available to players before playing a jackpot game) or into the cash box. This was achieved through "well balanced shut-off gates". (See paragraph 2.) Thus until the jackpot was full, one percentage (100%) of all wagers went into the jackpot. Once the jackpot was full, the

well-balanced shut-off gates were closed & another percentage (0%) of all wagers went into the jackpot. This ensured that the jackpot filled quickly, thus attracting players) while making sure that the operator made money. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bennett in view of Bueschel to dynamically change the percentage of the wagers devoted to the jackpot in order to ensured that the jackpot filled quickly, thus attracting players) while making sure that the operator makes money.

In the 1920's game designers did not have the technology to take a percentage of wagers less than 100% and assign it to the progressive jackpot. After all, a jackpot was a physical "pot" into which coins were placed. If a player placed a nickel in the slot, either the nickel went into the jackpot or it did not. It was impossible to split the nickel into pieces & place some of the pieces in the jackpot & some in the casino till.

Technology has advanced. A slot machine's jackpot is no longer a physical construct. It is a logical construct (i.e., an account) held in a computer's memory. A player's nickel can be divided any way that the casino desires since it is now represented electronically. Today, most progressive jackpots are funded by taking a portion of the player's wager that is less than 100% and assigning it to the progressive jackpot account in the casino's (or slot machine's) computers.

Clearly, it is within the level of ordinary skill to set the percentages going into the jackpot at any level desired —including less than 100%. Furthermore, since at least the 1920's practitioners of the art have been changing the percentages of wagers going into the jackpot based on jackpot level. (Any other criteria might be chosen if desired.)

Certainly, using percentages other than 100% would yield predictable results. Examiner concludes that it would have been obvious to assign a percentage less than 100% to the free game pot.

Regarding only, it should be noted that Bennett already has this feature. Since Bennett teaches dividing the existing jackpot into portions, Bennett always has a jackpot that is capable of funding all. Examiner however, interprets the claims as requiring the free games to be played only when the jackpot reaches a certain level.

Bueschel's double jackpot system's purpose was to ensure that the jackpot was full before a jackpot was awarded. In the 1920's, it was not possible to issue signals based on the level of the jackpot. In those days, designers had to rely on probability to keep the player from winning prior to the jackpot filling. However, with the computer age, it became possible to monitor the jackpot level & only allow a jackpot when the pool is full. This is what Acres teaches (see claim 8).

The importance of a full jackpot cannot be overestimated. If Bennett's jackpot does not reach a certain level, then it will not attract players. Players like to play for large amounts.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bennett in view of Bueschel & Acres to initiate the bonus round after the jackpot is at a level necessary to ensure full funding of all free games played during the free game round (i.e., reaches a certain level) in order to ensure that the jackpot is large enough to attract players.

Claim 22: Bueschel teaches a plurality of pots. The names of the pots (i.e., jackpot or free game pot) are immaterial and do not patentably distinguish over the prior art.

Claim 59: The choice of funding levels is a matter of design choice. A casino may choose any level of funding deemed appropriate. Acres teaches that the casino decides the appropriate funding level. Acres also teaches adjusting the frequency of bonus games based on current play conditions. (Paragraphs 294-296) Thus Acres suggests determining the funding level based on current conditions. This for instance, allows the casino to attract more players during slow times by offering more frequent bonuses. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bennett in view of Bueschel & Acres to set the level of the pot necessary to ensure full funding based on playing conditions.

Response to Arguments

3. Applicant's arguments filed 28 April 2008 have been fully considered but they are not persuasive.

4. Applicant argues that Examiner should withdraw the rejection because he refers to "jackpot" instead of "free game pot". This is not persuasive. As Juliet says, "What's in a name? That which we call a rose by any other name would smell as sweet." *Romeo and Juliet (II, ii, 1-2)*

5. Applicant's arguments concerning the function of the "free game pot" are not commensurate in scope with the claims. Furthermore, even if Applicant claimed the invention he is arguing, the prior art of record teaches all of the elements and, for the reasons set out in the rejection above, the combination of the elements is obvious. Bennett teaches a free game for

which the contents of a pot is the prize. Bueschel teaches dynamic funding of such a pot. And Acres teaches allowing several slot machines to play for the contents of such a pot. Whether the pot is called a "free game pot" or a "jackpot" is immaterial.

6. In response to applicant's argument that Bueschel has a different reason for cutting off funding to a particular pot, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

7. Applicant makes a number of arguments that suggest that mechanical slot machines are different from modern electronic slot machines. Examiner agrees that they are different. But the question is not whether they are different. The question is what the mechanical slot machines would suggest to one of ordinary skill in the art. Bueschel shows that the people in the 1920's were confronted with the same problem that Applicant seeks to address – how to fund a pot without over-funding it. They came to the same conclusion that the Applicant did – when the pot reaches a certain level, stop funding it. Simple common sense really. It worked in the 1920's and Examiner believes that 80-some years later, one of ordinary skill in the art would look at the slot machine in Bueschel & say, "When a pot is full, stop filling it – what a concept!"

8. Applicant argues that Acres does not teach that the casino determines funding levels of the pot. Applicant then quotes a section that states that the "turn-on level can also be set by the casino". Since the turn-on level is the level at which bonus game becomes available, this means that the casino determines the funding level for the pot. And since Acres also teaches adjusting

the frequency of bonus games based on current play conditions (Paragraphs 294-296), Acres suggests determining the funding level based on current conditions.

9. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Corbett B. Coburn/
Primary Examiner
Art Unit 3714